



# UNITED STATES PATENT AND TRADEMARK OFFICE

54  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,755	05/09/2001	Ethan Spiegel	081862P232D	5622

7590 06/14/2005  
Stephen T. Neal  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1026

EXAMINER

DUONG, FRANK

ART UNIT	PAPER NUMBER
----------	--------------

2666

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,755

Applicant(s)

SPIEGEL ET AL.

Examiner

Frank Duong

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-32 is/are allowed.
- 6) ☒ Claim(s) 33-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is a response to the amendment dated 02/22/05. Claims 11-43 are pending in the application.

#### ***Drawings***

2. The drawings were received on 02/22/05. These drawings are not acceptable because it would introduce new matter inconsistent with the parent application 08/876,952. The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application.

#### ***Specification***

3. The amendment filed 02/22/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Page 4, after line 11, "Figure 2 illustrates one embodiment ... System Addresses" and line 15, "Figure 2 illustrates ... component 230" and newly added Figure 2 are new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 2666

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 33-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding **claim 33**, there is no support for the claimed limitation of "a device, comprising.. an asynchronous transfer mode (A TM) communications component to communicate on an A TM network; a memory storage component to store an ATM address, which includes a private network-network interface PNNI peer group identification based on a manufacturer of the device and a product group to which the device belongs, to facilitate communication on the A TM network; an interface to allow the manufacturer of the device to input the A FM address into the memory storage J "\*" component at a point of manufacture automatically", recited in claim 33, in the specification. In accordance with the specification, on pages 5-9, in reference to FIG. 1, it is disclosed an autoconfigured ATM address 100 comprises a 20-byte ATM address value including AFI, manufacturer ID, manufacturer specific, switch ID and device ID fields. The specification does not disclose a device comprising an ATM communications component; a memory storage', and an interface in a manner set forth as recited in claim 33. From the disclosed features, the claimed limitation "a device, comprising: an asynchronous transfer mode (ATM) communications component to communicate on an ATM network; a memory storage component to store an ATM address, which includes a

Art Unit: 2666

private network-network interface PNNI peer group identification based on a manufacturer of the device and a product group to which the device belongs, to facilitate communication on the ATM network; an interface to allow the manufacturer of the device to input the ATM address into the memory storage component at a point of manufacture automatically cannot unambiguously derive to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

**Claims 34-43** fall with their parent claim 33.

This application is a divisional application of parent application 08/876,952. A careful review the specification of the parent application, Examiner also fails to find description for the claimed invention of claims 33-43. In a response to this Office Action, Applicants should cancel claims 33-43 because while a divisional application may depart from the phraseology used in the parent application there may be no departure therefrom in substance or variation in the disclosure that would amount to "new matter" if introduced by amendment into the parent application.

(note: Due to the problem discussed above, there is no a, applied to claims 33-43 at this time).

***Allowable Subject Matter***

5. Claims 11-32 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: Same as indicated in Office Action dated 11/30/04.

***Response to Arguments***

7. Applicant's arguments filed 02/22/05 have been fully considered but they are not persuasive.

In the Remarks of the outstanding response, on pages 9-10, pertaining the rejection of claims 33-43 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement, Applicant argues "*claims 33-34 comply with the written requirement ... MPEP 2163.02.*"

In response Examiner respectfully disagrees and asserts the rejection of claims 33-43 is proper for the following rationales:

This application appears to be a division of Application No. 08/876,952, filed 6/17/97. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application. While a divisional application may depart from the phraseology used in the parent application there may be no departure therefrom in substance or variation in the disclosure that would amount to "new matter" if introduced by amendment into the parent application. MPEP § 201.08 and §01.11.

The amendment filed 02/22/05 should it be entered would have introduce new matter in the prior application.

The cited portion of the original specification, as asserted by the Applicant, still does not reflect the claimed detailed structure of the claims 33-43. Thus, it fails miserably to comply with the written description requirement as set forth in the Office Action.

Examiner believes an earnest attempt has been made in addressing all of the Applicant's arguments. Due to the amendment fails to place the application in a favorable condition for allowance and the arguments are not persuasive, the rejection is maintained.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2666

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**FRANK DUONG**  
**PRIMARY EXAMINER**

June 12, 2005